

Remarks

In the instant application, claims 1-10 and 12 are pending. Claim 11 is hereby cancelled. Reconsideration of the pending claims in view of the forgoing amendments and following remarks is respectfully requested.

The Office Action states that claims 1-10 and 12 have been rejected under 35 U.S.C. § 112 and/or 35 U.S.C. § 103, however, claim 11 was not indicated as rejected in the Office Action. Applicants believe that claim 11 is allowable. The features of claim 11 have been incorporated into claim 1. As such, claim 1 is believed to be allowable.

Rejection under 35 U.S.C. § 112

Claims 1-10 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 1 has been amended to address this rejection. As such, the claims not comply with the written description requirement. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rauchschwalbe et al. (US Pat. Pub. No. 2001/0034453 (hereinafter referred to as " '453") in view of Merz et al. (*Journal for Praktische Chemie*, 1996, 672-674) (hereinafter referred to as "Merz").

The '453 publication, as best understood by the Applicants, discloses a decarboxylating process of 3,4 dialkoxythiophene-2,5-dicarboxylic acid in a solvent. The '453 publication does not disclose the process recited in claim 1. The process of claim 1 is carried out in the absence of solvent. In contrast, the '453 publication teaches a process being carried out in the presence of solvent and that such solvent serves to dissipate and distribute heat supplied via the reactor wall to avoid overheating. See the '453 publication at paragraph [0026]. Furthermore, the '453 publication does not disclose the process of claim 1 where the reaction is carried out in the presence of fluidized bed bodies. Merz does not add to the '453 publication to cure the deficiencies in order to teach every feature of instant claim 1. Specifically, there is no teaching or

suggestion in either the '453 publication or Merz to eliminate the solvent of the process of the '453 publication. The '453 publication states that the solvent is used to distribute heat from the reactor wall. Nowhere is there motivation or suggestion to eliminate the solvent since, according to the '453 publication, overheating may occur. As such, one skilled in the art would not eliminate the solvent in the process of the '453 publication in view of Merz.

Furthermore, the process of instant claim 1 provides unexpected results over the '453 publication alone or in combination with Merz. The yield of the process of the '453 publication, specifically that of Example 4 in paragraph [0047], is 86.7%. Further, the yield of the main product in Merz (3,4-dimethoxythiphene) is only 65%. See Merz on page 672, product 1). In contrast, product made according to the present invention was shown to obtain high selectivity in the absence of solvent as discussed on page 2, lines 22-31 of the instant specification. As set forth in instant Example 2, a yield of >94% was obtained. As such, the Applicants have shown unexpected results (i.e., higher yield) via the instantly claimed process over the cited art.

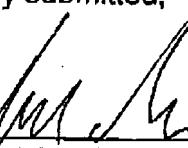
In view of the foregoing, it is respectfully submitted that the instant process as set forth in claim 1 is not obvious over the cited art. Withdrawal of the rejection is respectfully requested.

Claims 2-10 and 12 either directly or indirectly depend from claim 1 and are patentable over the cited references for at least the same reasons as set forth for claim 1. Withdrawal of the rejection of these claims is respectfully requested.

The USPTO is hereby authorized to charge any fees for an extension of time or those under 37 C.F.R. 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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